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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,640

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James E. Swon

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Varian Inc.

Legal Department

3120 Hansen Way D-102

Palo Alto, CA 94304

EXAMINER

HANDY, DWAYNE K

ART UNIT

PAPER NUMBER

1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/829,640	Applicant(s) SWON ET AL.	
	Examiner Dwayne K. Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the body". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-13, 15, 16, 18-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah (3,801,280). This rejection was originally applied to claims 1-5, 7-11, 15, 16 and 18-25 in Paragraph 3 of the Office Action mailed 10/04/06. It now includes claims 12 and 13. Claim 24 has been removed from this rejection. Please see Response to Arguments below.

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5. Claims 1-17, 21 and 23-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuellig et al. (6,126,904). This rejection was originally applied to claims 1-11, 15-17, 21-30 and 35-43 in Paragraph 4 of the Office Action mailed 10/04/06. It now includes claims 12-14 and 31-34. Claim 22 has been removed from this rejection. Please see Response to Arguments below.

6. Claims 1-4, 7-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen (6,582,116). This rejection was originally applied to claims 1-4, 7-11, 15, 16 and 18-20 in Paragraph 5 of the Office Action mailed 10/04/06. It now includes claims 12-14. Please see Response to Arguments below.

Response to Arguments

7. Applicant's arguments filed 12/12/06 have been fully considered but they are not persuasive. The rejection of claims 1-4, 7-11, 15 and 16 under Jahn has been removed.

Shah

8. Applicant has amended claims 1, 4 and 11 to recite a moveable component that includes a "sample carrier holder and drivable component attached to the sample holder" and argued that this feature is not shown in Shah (page 9, line 13 – page 10, line 22). The Examiner respectfully disagrees. In response to Applicant's amending of the claim the Examiner now directs Applicant to element 8 – the filter – from Figure 2 of

Shaw. The Examiner submits that the filter element meets this limitation. The filter (8) is a movable component comprised of a top (11) and a base (9) having an embedded magnet. Top (11) and base (9) are support members that form a "sample carrier holder".

9. Applicant has amended claim 15 and argued that Shah does not teach a container having sections of different dimensions (page 10, lines 23-28). The Examiner directs Applicant to Figure 1 which shows that the upper portion of the container (1) has a smaller diameter than the lower portion.

10. Applicant has also argued that Shah does not teach the limitations of claim 21 – particularly that Shaw fails to teach a support device (page 11, line 18 – page 13, line 8). In traversing this rejection, Applicant has directed the Examiner to the definition of the sample carrier and argued that Shah does not show this feature. The Examiner notes that this argument is beyond the scope of the claim as currently written. Claim 21 currently recites "a support device **for supporting a sample carrier**". Claim 21 does not positively recite the sample carrier. Supporting the sample carrier is an intended use of the support device. The support device is comprised of a body, two support members, and a coupling member attached to the body. This is what Shah shows with their filter element (8): a body (rod #26) having first and second support members (9 and 11) and a coupling member (magnet # 16) attached.

Zuellig

11. Applicant has amended claims 1, 4 and 11 to recite a moveable component that includes a "sample carrier holder and drivable component attached to the sample carrier holder" and argued that this feature is not shown in Shah (page 13, line 21 – page 14, line 22). The Examiner respectfully disagrees. Applicant has broadly claimed a movable component comprised of a "sample carrier holder" and a "drivable component". The Examiner submits that the agitator (35) of Zuellig still meets this limitation. In Figure 1C, Zuellig shows a variety of agitators. They are described in column 8, lines 8-24. In this passage, Zuellig notes that the agitator may have an encapsulated magnet. The agitator may also have surface modifications. In addition, the Examiner notes that Applicant has defined the carrier holder by it's function (i.e. the "sample carrier holder" simply holds the sample carrier – such as a stent - by contacting the surface of the holder with the stent). The Examiner considers the encapsulated magnet to be the drivable component. The outer portion of agitator is the "sample carrier holder". The Examiner also directs Applicant to the agitator at the bottom of Figure 1C. This agitator shows an outer surface having fins. The Examiner considers these fins to be first and second supporting members.

12. Applicant has amended claim 15 and argued that Zuellig does not teach a container having sections of different dimensions (page 14, lines 20-29). The Examiner directs Applicant to Figure 2. In this Figure, Zuellig shows a vessel (30) that has an upper section (41) with a larger diameter than the lower portion (42).

Nielsen

13. Applicant has amended claims 1, 4 and 11 to recite a moveable component that includes a “sample carrier holder and drivable component attached to the sample carrier holder” and argued that this feature is not shown in Nielsen (page 17, line 21 – page 14, line 22). The Examiner respectfully disagrees. Claims 1, 4 and 11 recite a movable component that includes a sample carrier holder and drivable component. As noted above, Applicant has defined the carrier holder by it’s function (i.e. the “sample carrier holder” simply holds the sample carrier – such as a stent - by contacting the surface of the holder with the stent). Therefore, the Examiner submits that Nielsen still meets this limitation. Nielsen shows an impeller blade (27) attached to a magnetic coupler (71). The Examiner considers the blade to be a “sample carrier holder” with the upper (81) and lower (69) protrusions to be “first and second support members”. The drivable component is the magnetic coupler (71) driven by the magnetic drive (column 7, lines 5-25).

14. Applicant has amended claim 15 and argued that Nielsen does not teach a container having sections of different dimensions (page 18, lines 1-11). The Examiner directs Applicant to Figure 1. In this Figure, Nielsen shows a vessel (5) that has a rounded bottom section that is of different dimensions than the rest of the vessel.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
March 5, 2007


Jill Warden
Supervisory Patent Examiner
Technology Center 1700